

Attorney Docket No. LEAP:125US
U.S. Patent Application No. 10/810,773
Reply to Office Action of March 31, 2006
Date: June 30, 2006

Amendments to the Drawings

An attached Replacement Sheet includes new Figure 7A, which has been added to original sheet 5/9. This change is merely to add an element that was originally recited in Claims 5, 9 and 18, but was not shown in the drawings. Since this new drawing has been added to illustrate a feature that was recited in the original claims, no new matter has been added. The Replacement Sheet may be found in the Appendix.

Remarks/Arguments

Objections to the Drawings

The Examiner objected to the drawings for failing to comply with 37 CFR 1.84(p)(4) because reference character 30 was used to designate both a slide mount glide and a slide mount guide. Paragraph [0024] has been amended to change guide to glide to repair a typographical error. Reference character 30 is now used to designate only a slide mount glide. No new matter has been added. Applicants request that the objection be withdrawn.

Specification Objections

Paragraph [0010] has been amended to change “be” to “by” to correct a grammatical error. No new matter has been added.

Paragraph [0016] has been amended to add the serial number of the applications that are referenced in the paragraph to more clearly identify the subject matter that is incorporated by reference in the present application. No new matter has been added.

Claims 5, 9, and 18 originally recited a spring-loaded ball bearing, which was not recited in the written description or illustrated in the drawings. Applicant has added new Figure 7A which illustrates the spring-loaded ball bearing that is recited in the original Claims 5, 9 and 18. Applicants have also amended paragraphs [0015] and [0025] to briefly recite language from Claims 5, 9 and 18. Figure 7A and amended paragraphs [0015] and [0025] now provide antecedent basis for the spring-loaded ball bearing. The amendments to the written description and new figure 7A are fully supported by the original language of Claims 5, 9 and 18 and no new matter has been added. Applicants request that the objection be withdrawn.

Claim Objections

Claim 20 was objected to for reciting the limitation “said slide holder” without proper antecedent basis. Claim 20 has been amended to recite “a slide holder.” Applicants request that the objection be withdrawn.

The Provisional Rejection of Claims 1-2, 4, 6, 10-11, 16 and 23 for Double Patenting

The Examiner rejected Claims 1-2, 4, 6, 8, 10-11, 16-17, 20 and 22-23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,402,576 (Stahl et al.). Applicants respectfully traverse this rejection and requests reconsideration.

Amended Claims 1 and 16, the two independent claims of the application, recite features that are patentably distinct over the claims recited in published U.S. Application No. 10/810,979 (Bonaventura). Specifically, Claim 1 now recites that the microscope stage drive mechanism is “detachably securable to said first and second engagement means.” A microscope stage drive mechanism that is detachably securable to a first and second engagement means enables the microscope drive mechanism to be attached to either the left or right side of the microscope stage. The claims of Bonaventura recite a stage, but fail to disclose a drive mechanism that is detachably securable to a first and a second engagement means, nor an obvious variant of that limitation. The drive means recited in the claims of Bonaventura is not capable of being detachably secured to a right or left side of the stage. Thus, Claim 1 is patentably distinct from the claims of Bonaventura.

Claims 2, 4, 6, 8 and 10-11 are dependent on Claim 1. Therefore, those claims also recite subject matter that is patentably distinct from the claims recited in Bonaventura. Applicants request that the rejection of Claims 1-2, 4, 6, 8 and 10-11 be withdrawn and those claims passed to allowance.

Claim 16 now recites that the drive mechanism is “detachably positionable to said microscope stage to more than one location of said stage.” A microscope stage drive mechanism that is detachably positionable to a microscope stage to more than one location of the stage enables such a microscope to be adaptable to either a left or right-handed user. The claims of Bonaventura recite a stage, but fail to disclose a drive mechanism that is detachably positionable to a microscope stage to more than one location of the stage, nor an obvious variant of that limitation. Thus, Claim 1 is patentably distinct from the claims of Bonaventura.

Claims 17, 20 and 22-23 are dependent on Claim 16. Therefore, those claims also recite subject matter that is patentably distinct from the claims recited in Bonaventura. Applicants request that the rejection of Claims 16-17, 20 and 22-23 be withdrawn and those claims passed to allowance.

The Rejection of Claims 1-2, 4, 6, 8, 10-11, 16-17, 20 and 22-23 Under 35 USC §102(b)

The Examiner rejected Claims 1-2, 4, 6, 8, 10-11, 16-17, 20 and 22-23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,402,576 (Stahl et al.). Applicants respectfully traverse this rejection and requests reconsideration.

Claim 1 has been amended to recite that the microscope stage drive mechanism is detachably securable to either a first or second engagement means. This amendment is fully supported by the original specification, and no new matter has been added.

Claim 1

As you know, each and every element of the invention as claimed must be found in a single prior art reference in order for a claim to be anticipated. Applicants respectfully submit that Stahl et al. fails to teach every element of the claimed invention as recited in Claim 1. Stahl et al. discloses a microscope adjusting device that is secured to one location on a microscope stage. Stahl et al. has no teaching that the adjusting means can be attached at any location other than the single location depicted in the sole figure. The specification is also void of any reference to a drive mechanism that is alternatively attached to either a first or second engagement means on the stage. Stahl et al. discloses an adjusting device for a microscope that has a coaxial drive means and a common release mechanism for simultaneously disengaging both drive means to facilitate rapid manual displacement of the stages to an approximate desired position. (See Abstract). Common release mechanism 36 is not a structural element that enables drive means 21,23 of stages 12,13 to be relocated to a new location on a stage. Drive means 21,23 are permanently located beneath cover 42. There is no structural feature that would permit the microscope drive means disclosed by Stahl et al. to be adapted for a left or right-handed user.

Claim 1 recites a drive mechanism that is detachably securable to a first or second engagement means on a microscope stage. Conventional microscopes are either left or right-handed models. Therefore, they are not adaptable to left or right-handed users. The invention recited in Claim 1 provides the user with the alternative to control a single microscope from the left or right side. Giving the alternative to detachably secure the drive mechanism to either the first or second engagement means provides a single microscope that can be used by either left or right-handed microscopists. Stahl et al. does not teach a microscope with that capability. More importantly, Stahl et al. fails to provide the structural elements of a microscope with a drive mechanism that can be attached to either a first location or a second location, i.e., left or right side.

Since a drive mechanism that is detachably securable to a first and second engagement means on a stage is not taught by Stahl et al., Claim 1 is novel and not anticipated by Stahl et al. Applicants respectfully request reconsideration and passage to allowance of Claim 1.

Claims 2, 4, 6, 8, 10-11 are dependent on Claim 1, and due to that dependency carry all the limitations of Claim 1. Therefore, Claims 2, 4, 6, 8, 10-11 are also patentable and Applicants respectfully request reconsideration and passage to allowance of Claims 2, 4, 6, 8, 10-11.

Claim 16

Claim 16 was also rejected as anticipated by Stahl et al. Applicants respectfully submit that all the elements of Claim 16 are not taught by Stahl et al., and thus Claim 16 is novel.

Stahl et al. discloses an adjusting device for a microscope that has a coaxial drive means and a common release mechanism for simultaneously disengaging both drive means to facilitate rapid manual displacement of the stages to an approximate desired position. (See Abstract). Common release mechanism 36 is not a structural element that enables drive means 21,23 of stages 12,13 to be relocated to a new location on a stage. Drive means 21,23 are permanently located beneath cover 42. There is no structural feature that would permit the microscope drive means disclosed by Stahl et al. to be adapted for a left or right-handed user.

Applicants respectfully disagree with Examiner Lavarias' position that Stahl et al. teaches a drive mechanism detachably securable to the microscope stage at more than one location of the stage due to the several screws 17 that are screwed into the base of stage 12. Stahl et al. does utilize screws 17, however, they mount gib 16 to base plate 11. Gib 16 is described as having one side that is Z-shaped, which is the location that the drive means is associated. Screws 17 may hold gib 16, but they do not secure the drive means at more than one location on the stage. (See Col. 3, lines 50-65).

Assuming *arguendo*, that Stahl et al. does teach that screws 17 attach a drive means at more than one location on the stage, which it does not, screws 17 do not detachably position a drive mechanism to more than one location of the stage. Amended Claim 16 now recites that the drive means is detachably positionable to more than one location on the stage. To, as opposed to at, describes a drive means that is detachably positionable to different positions on the stage. Swapping at for to removes any ambivalence as to whether the recited device in Claim 16 is merely attached to the stage by multiple attachment means or is detachably positionable to multiple points on the stage. Use of the word positionable further clarifies this point. Positionable connotes that the drive means can be positioned at more than one location, rather than merely attached at more than one location.

Applicants submit that for all of the above reasons independent Claim 16 is novel. Claims 17, 20 and 22-23 are dependent on Claim 16 and therefore are also novel due to that dependency. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 16, 17, 20 and 22-23 and passage to allowance of those claims.

The Rejection of Claims 3, 7, 19 and 21 Under 35 USC 103(a)

The Examiner rejected Claims 3, 7, 19 and 21 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 4,402,576 (Stahl et al.) in view of U.S. Patent No. 5,802,925 (Kanao). Applicants respectfully request reconsideration and traverse the rejection.

Claims 3 and 7

In responding to the anticipation rejection of Claim 1 based on Stahl et al. Applicants have shown that Stahl et al. fails to teach all the elements of the invention recited in Claim 1. Also, Kanao fails to teach the elements of Claim 1 missing from Stahl et al., thus the combination of Kanao and Stahl et al. fails to teach all the recited elements of Claim 1. Therefore, Claim 1 is patentable over Stahl et al. in view of Kanao. Claims 3 and 7 are dependent on Claim 1 and therefore have claim limitations that are also not taught by the combination of Stahl et al. and Kanao. Therefore, Claims 3 and 7 are patentable over Stahl et al. in view of Kanao.

Claims 19 and 21

In responding to the anticipation rejection of Claim 16 based on Stahl et al. Applicants have shown that Stahl et al. fails to teach all the elements of the invention recited in Claim 16. Also, Kanao fails to teach the elements of Claim 16 missing from Stahl et al., thus the combination of Kanao and Stahl et al. fails to teach all the recited elements of Claim 16. Therefore, Claim 16 is patentable over Stahl et al. in view of Kanao. Claims 19 and 21 are dependent on Claim 16 and therefore have claim limitations that are also not taught by the combination of Stahl et al. and Kanao. Therefore, Claims 19 and 21 are patentable over Stahl et al. in view of Kanao.

The Rejection of Claims 5, 9 and 18 Under 35 USC 103(a)

The Examiner rejected Claims 5, 9 and 18 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 4,402,576 (Stahl et al.) in view of U.S. Patent No. 3,428,387 (Hall et al.). Applicants respectfully request reconsideration and traverse the rejection.

Claims 5 and 9

In responding to the anticipation rejection of Claim 1 based on Stahl et al. Applicants have shown that Stahl et al. fails to teach all the elements of the invention recited in Claim 1. Also, Hall et al. fails to teach the elements of Claim 1 missing from Stahl et al., thus the combination of Hall et al. and Stahl et al. fails to teach all the recited elements of Claim 1. Therefore, Claim 1 is patentable over Stahl et al. in view of Hall et al. Claims 5 and 9 are dependent on Claim 1 and therefore have claim limitations that are also not taught by the combination of Stahl et al. and Hall et al. Therefore, Claims 5 and 9 are patentable over Stahl et al. in view of Hall et al.

Furthermore the element recited in Claims 5 and 9, a spring-loaded ball bearing, is not taught by Hall et al. Hall et al. teaches a pressure roller urged by a spring to engage the roller to press rod 25 into frictional engagement with V pulley 26. The spring-loaded ball bearing of Claims 5 and 9 is used to detachably secure the stage drive mechanism to the stage. It has nothing to do with preventing the slipping of the stage drive mechanism during use. In order to combine references to support an obviousness rejection there must be a suggestion or motivation to combine the cited references. In this case, the Examiner has stated that one of ordinary skill in the art would be motivated to combine Hall et al. with Stahl et al. since a spring urged roller would keep the drive mechanism from slipping. This motivation is born out of hindsight reconstruction since such a spring urged roller is unnecessary to prevent the drive mechanism of the claimed invention from slipping. The use of a spring loaded ball bearing as recited in Claim 5 and 9 is to detachably secure the drive mechanism to the stage, not prevent slipping of the drive mechanism.

Furthermore, a spring loaded ball bearing is entirely different than a roller (or wheel) that is urged by a spring. A roller is not capable of receiving and holding a drive mechanism into mounting hole 24 as adeptly as a spring loaded ball bearing since it has smooth surfaces on only two sides of the wheel. A ball bearing has an entirely smooth surface, which can receive the drive mechanism from various angles. The roller or wheel that Hall et al. teaches, if implemented

in the invention recited in Claims 5 and 9, would only accept the drive if it was inserted at an angle roughly perpendicular to the mounting hole (and that is only if the roller is oriented correctly). A smooth ball bearing can accommodate the insertion of a drive mechanism from various angles since it has a smooth surface that can yield to the drive mechanism from various acute angles. Therefore, the roller and spring taught by Hall et al. is not analogous to the spring-loaded ball bearing recited in Claims 5 and 9, and this claim limitation is not taught by the combination of Stahl et al. and Hall et al.

For the reasons stated above Claims 5 and 9 are patentable over Stahl et al. in view of Hall et al. and Applicants respectfully request that the rejection of those claims be withdrawn and Claims 5 and 9 passed to allowance.

Claim 18

In responding to the anticipation rejection of Claim 16 based on Stahl et al. Applicants have shown that Stahl et al. fails to teach all the elements of the invention recited in Claim 16. Also, Hall et al. fails to teach the elements of Claim 16 missing from Stahl et al., thus the combination of Hall et al. and Stahl et al. fails to teach all the recited elements of Claim 16. Therefore, Claim 16 is patentable over Stahl et al. in view of Hall et al. Claim 18 is dependent on Claim 16 and therefore has claim limitations that are also not taught by the combination of Stahl et al. and Hall et al.

Applicants have argued above that the roller and spring taught by Hall et al. is not analogous to the spring-loaded ball bearing recited in Claims 5 and 9. Those arguments also apply to the patentability of Claim 18 and are not repeated for the sake of brevity. Consequently, the roller and spring taught by Hall et al. is not analogous to the spring-loaded ball bearing recited in Claim 18, and this claim limitation is not taught by the combination of Stahl et al. and Hall et al.

For the reasons stated above Claim 18 is patentable over Stahl et al. in view of Hall et al. and Applicants respectfully request that the rejection of that claim be withdrawn and Claim 18 passed to allowance.

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Conclusion

Applicants respectfully submit that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



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